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K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690				
EXAMINER				
AL AUBAIDI, RASHA S				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,252

Applicant(s)

KLEINER ET AL.

Examiner

RASHA S. AL AUBAIDI

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. This in response to RCE amendment filed 01/15/2009. No claims have been added. No claims have been canceled. Claims 1 and 8 have been amended. Claims 1-8 are still pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites "setting up only a connection for the transmission of pure signaling".

It is not clear why only connection for the transmission of pure signaling is set up"? And to server what purpose. It seems that the connection is set up only to distinguish the type of information. Also, it is not clear what exactly meat by the claimed "pure signaling information" as recited in the claim. Clarification is required.

Claim 8 is rejected for the same reasons as discussed above with respect to claim 1.

Dependent claims 2-7 are rejected for the same reasons as discussed above with respect to claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson et al (US PAT # 4,873,717) in view of Foster et al. (US PAT # 4,757,526).

Regarding claim 1, Davidson teaches a method for handling an incoming call to or an outgoing call from a subscriber terminal (see col. 7, lines 50-52) within a digital telecommunications switching center of a telecommunication network (reads on the ISDN, see col. 4, lines 60-68), comprising: switching a connection on for the transmission of signaling information and useful information (this reads on sending the message that contains information about the call, see col. 13, lines 1-6 also, col. 9, lines 4-6) between a calling subscriber terminal and an accepting subscriber terminal when there is an incoming call in the digital telecommunications switching center (see col. 13, lines 12-14), or a connection for the transmission of signaling information and useful information (this reads on sending the message that contains information about the call, see col. 13, lines 1-6 also, col. 9, lines 4-6) between the calling subscriber terminal

of the subscriber group and the accepting subscriber terminal being switched when there is an outgoing call in the digital telecommunications switching center (see col. 13, lines 8-10); and setting up a ¹connection for the transmission of pure signaling information between the calling subscriber terminal and the accepting subscriber terminal of the subscriber group in the digital communication center (setting up a connection is extremely an inherent feature. Also, this feature can read on "call forwarding", see col. 17, and lines 1-53).

Davidson does not specifically teach that the subscriber terminal is actually within a "Centrex group" as recited in claim 1.

However, Foster specifically teaches of providing services (i.e., call transfers and conferencing) to a subscriber terminal within the environment of Centrex groups (col. 1, lines 11-36 and col. 2, lines 58-60). Also, the claimed feature of "at least one further subscriber terminal being assigned to the Centrex group" is already taught by Foster (see col. 2, lines 55-57).

Therefore, it would have been obvious to one of ordinary skill in the art to have Davison's subscriber terminal implemented in a Centrex group, such as the one taught in Foster. Advantages of the Centrex are old and well known in the art. For example, Centrex will allow users to broaden their internal communication access and distribution

¹ Note that when the call is first captured at the first station (this reads on the first connection) and then

quickly and cost effectively, without the expense of owning and maintaining a private network.

Claim 8 is rejected for the same reasons as discussed above with respect to claim 1. The claimed feature of "setting up **only** a connection...etc" as recited in claims 1 and 8 is extremely obvious and well known in the art. Obviously one can choose to set me a connection only without transmitting any information **or** setup the connection in order to transmit any type of information desired (i.e., useful or not useful).

Regarding claim 2, Davidson teaches each subscriber terminal (reads on the three key-system groups subscribers terminals 170,180, and 190, see col. 6, lines 59-62) of the Centrex group is assigned a primary number (see col. 6, line 67) and at least one associated call number (this is inherent and it reads on the last 4 digits of the terminal extension number xxxx, since we are considering the primary directory number is the first 3 digits), each corresponding to the primary call number of another subscriber terminal of the Centrex group (this basically means that each associated call number which is the extension is associated with primary number of the other subscriber terminal since all the subscribers share the same primary directory number, see col. 1, lines 25-30, col. 3, lines 37-38 and lines 46-49, see also, col. 7, lines 18-22 and Fig. 1).

the call is forwarded to the second stations (this reads on the second connection in the system).

Regarding claim 3, Davidson teaches when an incoming call directed to a first subscriber terminal of the Centrex group is transferred by a second subscriber terminal (this may read for example on the leading terminal 181, see col. 9, lines 53-65) of the Centrex group in the digital telecommunications switching center, switching a connection for the transmission of signaling information and useful information to the second subscriber terminal, and maintaining a connection for the transmission of pure signaling information to the first subscriber terminal (In Fig. 2, ISDN terminal 182 provided with a transfer button to perform the transfer functionality. Also, this may simply reads on the scenario of the secretary who is transferring calls to different extensions (see col. 1, lines 30-61).

Regarding claim 4, Davidson teaches before an incoming call which is directed to a first subscriber terminal and which is associated with the Centrex group is accepted or transferred by a second subscriber terminal which is associated with the Centrex group, assigning the subscriber information which is associated with the first subscriber terminal and which is obtained from a central database of the digital telecommunications switching center, for the duration of the connection, to a subscriber line group which is located in the digital telecommunications switching center and connects the second subscriber terminal (this basically reads on transferring the calling subscriber information to the called subscriber, see col. 8, lines 52-68 and col. 9, lines 1-8. Davidson teaches displaying information about the called and the calling party to

the shared secretary (see also, col. 2, lines 53-60 and col. 3, lines 7-27 as well as Fig. 15).

Claim 6 is rejected for the same reasons as discussed above with respect to claim 3. Also, the imitations recited in claim 6 are inherent.

Claims 7 and 5 are rejected for the same reasons as discussed above with respect to claim 4. The imitations recited in claims 5 and 7 are inherent.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant's argues (page 5 of the Remarks) that "the reference fails to disclose switching of a connection for the transmission of signaling information and useful information, e.g., voice data". The Examiner respectfully disagrees, first, the claimed "voice data" is not recited in the claim's language. Second, since the "voice data" is not recited the claimed "usual information" will have the broadest reasonable interpretation. In other words, the claims must be given their broadest reasonable interpretation consistent with the specification and the interpretation that those skilled in the art would reach. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), and *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13,

2004). Any term that is not clearly defined in the specification must be given its plain meaning as understood by one of ordinary skill in the art. See MPEP 2111.01. See also *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), *Sunrace Roots Enter Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003), *Brookhill- Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir.2003).

The interpretation of the claims by their broadest reasonable interpretation reduces the possibility that, once the claims are issued, the claims are interpreted more broadly than justified. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

Thus, the claimed "useful information" still reads on Davison internal controlled message that contains information about the call, including calling number and call type filed (see col. 13, lines 1-6)

Also, Applicant's argues "The reference also fails to disclose setting up only a connection for transmission pf pure signaling information...etc". The Examiner respectfully disagrees, because if the reference is capable of setting up a connection that transmits information it is absolutely obvious that the reference is capable to set up a connection without the need to transmit information (i.e., connection only). Thus, the feature of "setting up only a connection...etc" is extremely obvious and well known in the art. Obviously one can choose to set me a connection only without transmitting any information or setup the connection in order to transmit any type of information desired

(i.e., useful or not useful). In conclusion, "setting up **only** a connection" does not rise the invention to the level of patentability.

On Page 6 of the Remarks, "Applicant submit that there would have been no reason for one to modify Davidson to provide a Centrex group. Doing so would not add anything to the system disclosed in Davidson".

First, the Examiner relied on using the teachings of Davidson in a Centrex environment such as the one taught by Foster. Second, Examiner's position is that the use of the teachings of Davidson in a well known Centrex environment does not rise to the level of patentability, since Applicant is not inventing the Centrex. The use of Centrex is old and notoriously well known in the art. Changing the environment of a primary reference to simply use another old and well known environment such as Centrex would have been obvious.

Applicant also adds "the Examiner has not pointed to any specific evidence of record which supports that stated motivation to combine these references. Merely stating that Centrex has Advantages...etc". The Examiner believes that there is no evident required to point out the Advantages of an old and a well known system (i.e., Centrex) in the art of telephony. These Advantages are notorious to one of ordinary skill in the art, such as cost effectiveness, without the expense of owning and maintaining a private network.

The Examiner believes that other Applicant's arguments are already met in the above rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on (571) 272-7493.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rasha S AL-Aubaidi/

Primary Examiner, Art Unit 2614

